

Remarks:

Claims 1-14 are pending in the application. Claims 1-14 are rejected. In view of the following remarks, applicant requests reconsideration of the rejected claims under 37 C.F.R. § 1.111.

Rejections under 35 U.S.C. § 103

Claims 1-14 are rejected under 35 U.S.C. § 103 as being obvious over Sevcik et al. (U.S. Patent No. 6,330,542) or Kara (U.S. Patent No. 5,983,209) in view of Farrell (U.S. Patent No. 5,383,129, Robinson et al. (U.S. Patent No. 5,850,584) or Darlington (U.S. Patent No. 5,102,200). Sevcik et al. discloses an automated Internet quoting and procurement system that provides a graphical interface between buyers of commercial printing services and the providers of those services, as shown in the figure below.

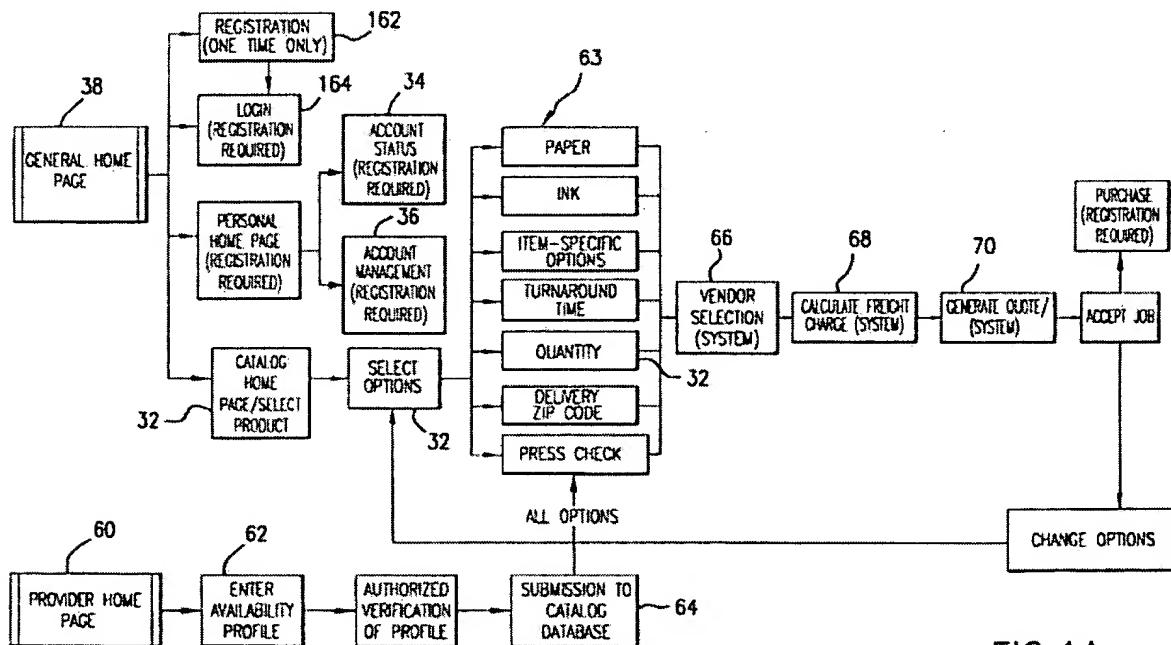


FIG. 1A

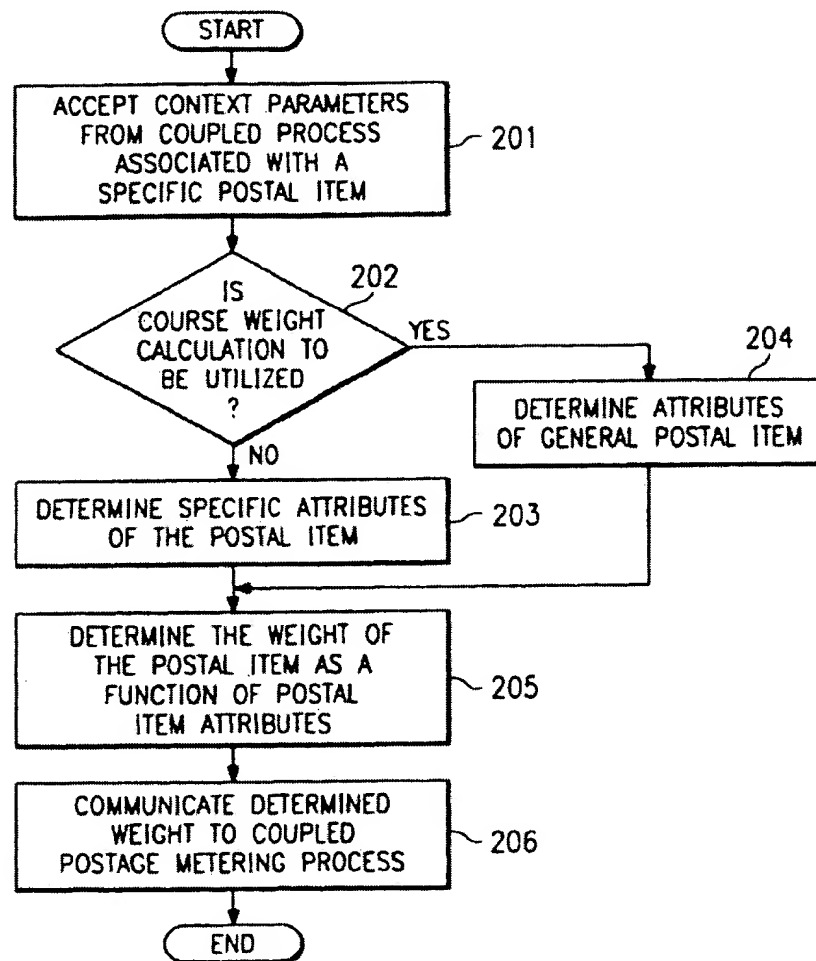
The system allows the print buyer to select among various job options at 63 to specify the desired print product. The job options include quantity, turnaround time, press check, delivery zip code and shipping method. Based on those selected options, the system selects the appropriate vendors at 66, computes the weight of the order based on quantity and paper weight, computes the freight cost at 68, and displays the most competitive pricing and freight cost at 70 (col. 9, Ins. 24-50).

Sevcik et al. does not disclose, teach or suggest a method or system that includes providing an electronic print job having predefined electronic print job attributes that identify weight-determining factors including at least one of printer technology, ink/toner coverage and ink/toner weight, as recited in claim 1. The Examiner, in fact, acknowledges that Sevcik et al. fails to "explicitly [teach] that the weight-determined factors include at least one of printer technology, ink/toner coverage and ink/toner weight." The Examiner further indicates that this failure likely is an assumption that the weighting factor due to ink/toner printed on the surface of the sheet is very low as compared to the weight of the sheet and that the precise weight is not critical. The Examiner thus appears to argue that there is no motivation to modify Sevcik et al. to read on applicant's claims. Nevertheless, the Examiner asserts that it would have been obvious to include ink/toner (or printed material) weight on coverage as part of the weight-determining factor. Applicant respectfully disagrees.

As acknowledged by the Examiner, Sevcik et al. calculates weight of an order based only on the quantity and paper weight (column 9, lines 44-45). There is no suggestion to expand the indicated weight-determining criteria, and no motivation to do so (according to the Examiner's own interpretation of Sevcik et al.).

Kara discloses a system and method for determining the weight of a postal item, as shown in the figure below.

FIG. 2



As indicated, the operator chooses between a course (estimated) weight based on attributes of a general postal item at 204 or a precise weight based on specific attributes of the postal item at 203 (col. 6, lns. 12-16). The attributes available for consideration are paper size, print mode, paper stock weight, associated envelope

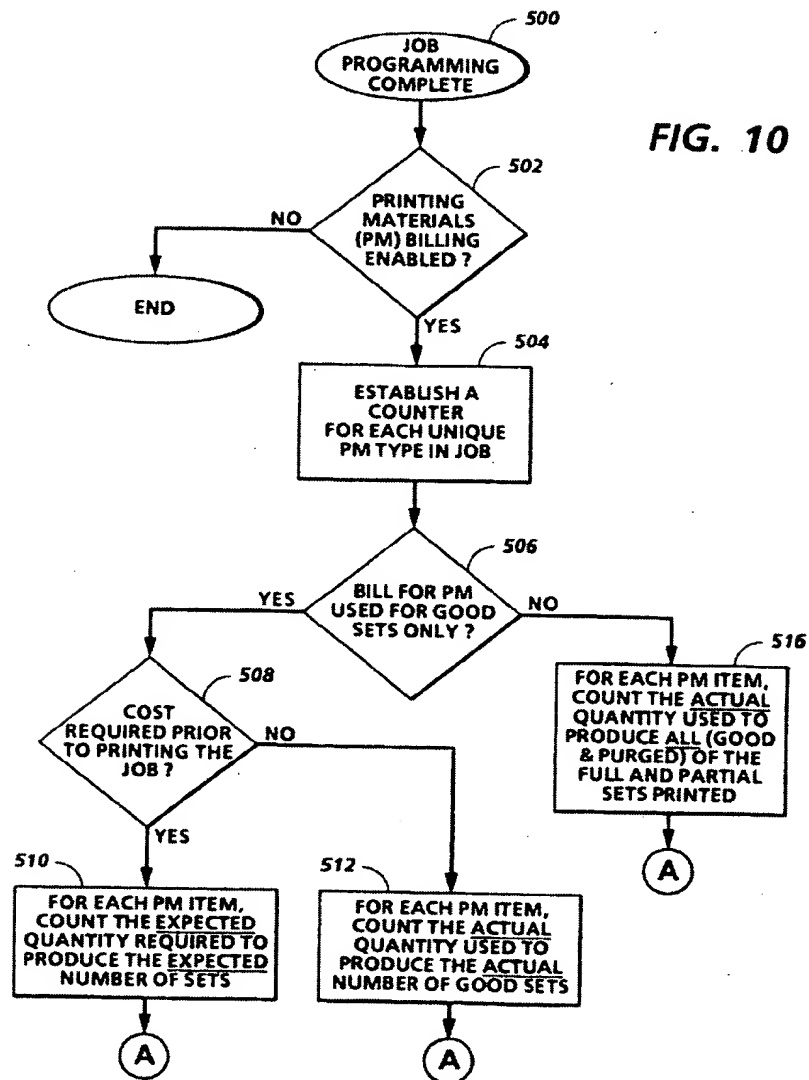
and envelope weight. Specific attributes are stored in the system in the form of a data array similar to the table below (see column 6, lines 35-50):

| <u>Context Specific Attribute Information</u> | | | | | |
|---|------------|----------------|--------------------|---------------------|-----------------|
| Process | Paper Size | Print Mode | Paper Stock Weight | Associated Envelope | Envelope Weight |
| Word Processor | 8.5 x 11 | Draft | 15# | #10 | .05 |
| Word Processor | 8.5 x 11 | Correspondence | 20# | #10 | .05 |
| Word Processor | 5 x 7 | Correspondence | 25# | N/A | N/A |
| Spread Sheet | 8.5 x 11 | N/A | 15# | 10 x 13 | .50 |
| Spread Sheet | 11 x 14 | N/A | 15# | 12 x 15 | .60 |

At 205 and 206, the system determines the weight of the postal item based on the postal item attributes, and then communicates the weight for postage metering.

Kara does not disclose, teach or suggest a method or system that includes providing an electronic print job having predefined electronic print job attributes that identify weight-determining factors including at least one of printer technology, ink/toner coverage and ink/toner weight, as recited in claim 1. In fact, the Examiner specifically recognizes that Kara fails to explicitly teach that the weight-determining factors include at least one of printer technology, ink/toner coverage and ink/toner weight, and reasons that such weighting factors are not considered "because it's reasonable to assume that the weighting factor due to ink/toner printed on the surface of the sheet is very low as compared to the weight of the sheet and precise weight figure is not critical". The Examiner thus appears to argue that there is no motivation to modify Kara.

Farrell discloses a method of estimating cost of printing materials, as shown in the figures below.



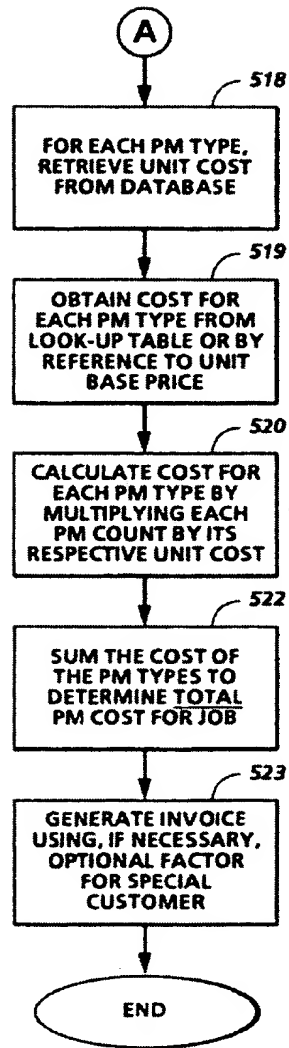


FIG. 11

The method involves establishing a counter for each unique printing material type at 504, and then counting the expected quantity at 510 or the actual quantity at 512 or 516 used for the print job. Those printing material counts are then multiplied by respective unit costs retrieved from a database at 520. The costs are summed to determine the total printing material cost for the printing job at 522 (col. 7, ln. 46 to col. 9, ln.29).

Farrell does not disclose, teach or suggest a method or system that includes providing an electronic print job having predefined electronic print job attributes that identify weight-determining factors including at least one of printer technology, ink/toner coverage and ink/toner weight, as recited in claim 1. Additionally, Farrell does not disclose, teach or suggest a method that includes calculating a weight of the electronic print job via a computer using the weight-determining factors, as recited in claim 1. In fact, contrary to Examiner's assertions, Farrell does not even mention a method that identifies weight-determining factors, much less a method that uses weight-determining factors to calculate a weight of an electronic print job.

Robinson et al. discloses a method for estimating the cost of a printing job based on the image to be printed on that job. The method includes estimating the amount of each colorant to be used for the image. Cost of the printing job is then estimated based on pre-entered costs per unit mass for each colorant. Additionally, the method may include the cost of the paper to be used for the job (col. 6, ln. 27 to col. 7, ln. 61).

Robinson et al. does not disclose, teach or suggest a method or system that includes calculating a weight of the electronic print job via a computer using weight-determining factors, as recited in claim 1. Additionally, Robinson et al. does not disclose, teach or suggest a method that includes calculating postage for the electronic print job using the calculated weight of the print job, as recited in claim 1. In fact, the method in Robinson et al. is focused only on estimating the cost of the print job based on the amount of colorant and paper to be used. There is no suggestion or motivation to calculate the weight of the electronic print job, much less to use that calculated weight to determine postage for the electronic print job.

Darlington discloses a method for de-inking waste paper using alkoxy capped polyethylene oxide and a polymeric material. Such a reference cannot be combined with either Sevcik et al. or Kara because Darlington is nonanalogous art and therefore is improper to combine with Sevcik et al. or Kara.

In the case of *In re Clay*, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992), the Federal Circuit provided the test to determine whether a reference in the prior art is "analogous" or not:

Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.

Darlington is not from the same field of endeavor and is not reasonably pertinent to the particular problem at hand. First, Darlington's field of endeavor is the recycling of secondary fiber (col. 1, Ins. 20-35). In contrast, applicant's invention relates to calculating postage associated with mailing a printed document. Second, Darlington is concerned with providing a method of de-inking secondary fiber printed by reprographic printing processes (col. 2, Ins. 3-7), while applicant's invention is concerned with estimating postage prior to printing hardcopies of a print job. Thus, Darlington is not from the same field of endeavor and is not reasonably pertinent to the particular problem at hand. Therefore, Darlington is nonanalogous art.

Additionally, there is no suggestion, motivation or teaching to combine Darlington with Sevcik et al. or Kara. As discussed above, Darlington discloses a method of de-inking secondary fiber printed by reprographic printing process. In contrast, Sevcik et al. discloses an automated internet quoting and procurement system for commercial printing, and Kara discloses a system or method for determining postal item weight. A person skilled in the art and confronted with problems inherent in Sevcik et al. or Kara would not consult the teachings of Darlington, or vice-versa.

Moreover, even the improper combination of Darlington with either Sevcik et al. or Kara does not disclose, teach or suggest a method or system that includes providing an electronic print job having predefined electronic print job attributes that identify weight-determining factors including at least one of printer technology, ink/toner coverage and ink/toner weight, as recited in claim 1.

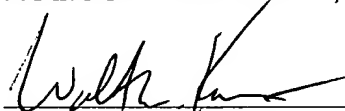
For at least the foregoing reasons, the rejection of claim 1 under 35 U.S.C. § 103 should be withdrawn. Claims 2-10 depend from claim 1, and thus are allowable for at least the same reasons as claim 1.

Like claim 1, independent claim 11 recites providing an electronic print job having predefined electronic print job attributes that identify weight-determining factors including at least one of printer technology, ink/toner coverage and ink/toner weight. Claim 11 thus is allowable for at least the same reasons as claim 1. Claims 12-14 depend from claim 11 and thus are allowable for at least the same reasons as claim 11.

Applicant believes that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, applicant respectfully requests that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on June 6, 2005.



Christie A. Doolittle